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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,319	06/11/2001	William T. Donofrio	2640/1G819USI	5187

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EXAMINER

NGUYEN, VI X

ART UNIT PAPER NUMBER

3731

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,319

Applicant(s)

DONOFRIO ET AL.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 and 66-68 is/are pending in the application.
- 4a) Of the above claim(s) 11-26, 29, 41-56, 59 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 27, 28, 30-40, 57, 58 and 66-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group 1, claims 1-60 and 66-68 and Species I, Figs. 2a, 2b in Paper No. 8 is acknowledged. However, applicant did not provide any reason as why to the restriction is improper. It would appear that claims 1-10, 27-28, 30-40, 57-58 and 66-68 relate to Species I, Figs. 2a, 2b. Claims 11-26, 29, 41-56, 59 and 60 are drawn to Species IV which illustrates a ring embodiment for the switch for the hand piece. Therefore, none -elected claims 11-26, 29, 41-56, 59 and 60 are withdrawn from further consideration.

The requirement is deemed proper and is therefore made **Final**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 27, 28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 8, it is unclear what is meant by "if a **monitored pressure** on the switch" and how it relates to the system for implementing surgical procedures. Apparently, the applicant was referring to "a sensor" in claim 66.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 ,27, 28, 30-40, 57-58 and 66-68 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Thomas (5,026,387) in view of Kubota et al (4,979,952).

Regarding claims 1, 31 and 66-68, Thomas discloses a system for implementing surgical procedures including: an ultrasonic surgical handpiece (2) has an end-effector (3), a generator (1) controls the handpiece, wherein an electrical connection (fig. 1) connects the handpiece and the generator. The generator (1) sends a drive current to drive the handpiece (2) which imparts longitudinal movement to the end-effector (3); and wherein a finger-operated switch (6a) provides on a housing of the handpiece (2), the switch activates the handpiece at a first power level. However, Thomas does not disclose if a monitor pressure on the switch reaches a high threshold and deactivating the handpiece if the monitor pressure reaches a low threshold. Kubota et al teach "pressure-activated" switch (Figs 1, 2, 8 and col. 4, lines 65-67, col. 5, lines 1-10, col. 7, lines 56-68).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Thomas by adding a "pressure-activated" switch as taught by Kubota et al in order to provide sufficient pressure activated switch which makes the device more assessable for the user. Furthermore, it is noted that such a "pressure-activated" switch is merely a common switch activated by the pressure of a user's finger and deactivated by the release of the user finger.

Regarding claims 2-5, 32-34 and 40, Thomas discloses the switch (6a) is distally located on the handpiece (2). The handpiece is operated at a power level, wherein the pressure is monitored by

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a sensor located inside the handpiece (2) which selected from a group consisting of an electro-mechanical switch, a sensitive resistor (col. 5, lines 61-67 and col. 6, lines 1-3); and wherein the switch includes a pair of switch button members (6a).

Regarding claims 6-8 and 35-37, Thomas discloses the switch (6a) has a region for resting of a finger (fig. 1); and wherein the switch (6a) is aligned and indexed to the end-effector (3).

Regarding claims 9-10 and 38-39 Thomas fails to disclose a first and a second post are extending outwardly away from the surface; and wherein a first raised section and a second raised section on the upper surface of the switch, said raised section is supported by a recessed section formed there between. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to construct the Thomas' device with a first and a second post are extending outwardly away from the surface; and wherein a first raised section and a second raised section on the upper surface of the switch, said raised section is supported by a recessed section thereof, since it has been held to be within the general skill of worker in the art to make plural parts unitary as a matter of obvious engineering choice. In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951).

Regarding claims 27-28, 30 and 57-58, Thomas discloses the switch (6a) has an inadvertent activation. The switch is a hysteresis switch (6a); and wherein the switch provides its switching functionality according to a lagging effect.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,252,334 to Nye

U.S. Pat. No. 4,321,530 to Kelly

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U.S. Pat. No. 5,060,658 to Dejter


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

vn *W*
June 21, 2003


MICHAEL J. MILANO
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